

### **REMARKS**

Claims 1-12 were previously pending, of which claims 1, 4, 10, and 12, have been amended, and new claims 13-20 have been added; therefore, claims 1-20 are currently pending. No new matter has been added as a result of the amendments or the new claims. Reconsideration and allowance of the pending claims is respectfully requested in light of the following remarks.

#### **Claim Amendments**

The claim amendments effected herein are for the purposes of clarification only. The amendments are not related to the issue of patentability of the claims and are not submitted in response to or to overcome any rejection of the claims based on the prior art or otherwise.

#### **Double Patenting Rejections**

Claims 1-9 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Chen et al. (U.S. Patent No 6,668,241, hereinafter referred to as “’241”) in view of Husseiny (U.S. Patent no. 5,210,704, hereinafter referred to as “Husseiny”).

Claims 10-12 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 7 and 9 of ‘241.

In response, Applicants respectfully request that the Examiner hold in abeyance any requirement that Applicants’ submit a Terminal Disclaimer in compliance with 37 C.F.R. §1.321(c) until such time as one or more claims are indicated as being otherwise allowable.

#### **Rejections under 35 U.S.C. §103**

Claims 1 and 2 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Kekic et al. (U.S. Patent No. 5,999,179, hereinafter referred to as “Kekic”) in view of Husseiny.

Claim 3 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Kekic in view of Husseiny, as applied to claim 1, and further in view of Pisello et al. (U.S. Patent No. 5,678,042, hereinafter referred to as “Pisello”).

Claims 4 and 6-9 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Kekic in view of Husseiny and Bergholm et al. (U.S. Patent No. 5,761,432, hereinafter "Bergholm").

Claim 5 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Kekic in view of Husseiny and Bergholm, as applied to claim 4, and further in view of Pisello.

Claims 10-12 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Kekic in view of Husseiny and Pisello.

Applicants respectfully traverse the subject rejection on the grounds that the cited references are defective in establishing a prima facie case of obviousness with respect to the pending claims.

As the PTO recognizes in MPEP § 2142:

*... The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness...*

It is submitted that, in the present case, the Examiner has not factually supported a prima facie case of obviousness for at least the following, mutually exclusive, reasons.

**1. Even When Combined, the References Do Not Teach the Claimed Subject Matter**

The Kekic and Husseiny patents cannot be applied to reject independent claim 1 under 35 U.S.C. §103 because, even when combined, the references do not teach the claimed subject matter.

In particular, the cited references fail to teach or suggest at least the following elements as recited in independent claim 1:

*a program for creating one or more analytical reports about the monitor set based on the rules and the data, wherein the one or more analytical reports include a prediction of exhaustion of the equipment, wherein the program includes:*

*an inference engine having instructions for . . . firing the rule on the data to produce an analysis and to create the one or more analytical reports.*

Applicants respectfully traverse the Examiner's position that Kekic teaches "a program for creating one or more analytical reports . . . wherein the program includes an inference engine having instructions for firing the rule on the data to produce an analysis and formatting the analysis into the analytical reports," as recited in claim 1. On the contrary, at most the sections of Kekic cited by the Examiner disclose upon the firing of a rule, logging an event to an alarm log. Applicants submit that this is not equivalent to firing a rule **to produce an analysis to create the one or more analytical reports**. In particular, logging an event in an alarm log is not equivalent to producing an analysis; similarly, an alarm log, which comprises merely a listing of certain events, is not equivalent to an analytical report.

Husseiny fails to remedy the deficiencies of Kekic in this regard. Additionally, Husseiny, which is cited by the Examiner as teaching "an analytical report which includes a prediction of exhaustion of the equipment," fails to do so. Specifically, while Husseiny does generally address predicting equipment failure, it fails to teach or suggest creating an analytical report that includes such a prediction. In view of this and the fact that Husseiny fails to remedy the deficiencies of Kekic, as described above, it is apparent that, even when combined, the references do not teach the subject matter as claimed in independent claim 1; therefore, the subject rejection thereof should be withdrawn.

The Kekic, Husseiny, and Bergholm patents cannot be applied to reject independent claim 4 under 35 U.S.C. §103 because, even when combined, the references do not teach the claimed subject matter. In particular, the cited references fail to teach or suggest at least the following elements as recited in independent claim 4:

*defining a review for the selected configuration, the review  
identifying one or more rules usable to calculate exhaustion of the  
equipment;*

and

*receiving a comparison of the data and the review.*

Applicants respectfully traverse the Examiner's position that Kekic teaches defining a review for the selected configuration identifying one or more rules, as recited in claim 4. On the contrary, at most the sections of Kekic cited by the Examiner disclose defining a general rule to be applied by the system upon the occurrence of certain conditions. Applicants submit that this is not equivalent to defining a **review** for a **selected configuration**, wherein the review identifies one or more rules. Accordingly, as recited in claim 4, a review is separate from, although comprised of, a rule; Kekic teaches only the definition of a rule, not of a review comprising one or more rules and pertaining to a selected configuration. Moreover, even assuming *arguendo* that Kekic's teaching of defining a rule is equivalent to Applicant's defining a review, Kekic fails to teach receiving a comparison of the data and the defined rule.

Husseiny, which is cited by the Examiner as teaching a rule-based monitoring expert system including at least one rule usable to calculate exhaustion of the equipment, and Bergholm, which is cited by the Examiner as teaching step of and means for obtaining equipment related data using a separate inventory system, fail to remedy the deficiencies of Kekic in this regard. Accordingly, it is apparent that, even when combined, the references do not teach the subject matter as claimed in independent claim 4; therefore, the subject rejection thereof should be withdrawn.

Finally, the Kekic, Husseiny, and Pisello patents cannot be applied to reject independent claim 10 under 35 U.S.C. §103 because, even when combined, the references do not teach the claimed subject matter. In particular, the cited references fail to teach or suggest at least the following element as recited in independent claim 10:

*a program for creating one or more analytical reports about the monitor set based on the rules and the data, wherein at least one of the analytical reports details a relationship between demand and capacity for at least a portion of the equipment.*

Applicants respectfully traverse the Examiner's position that Kekic teaches a program for creating one or more analytical reports for the reasons set forth in detail above with respect to claim 1.

Husseiny, which is cited by the Examiner as teaching a rule-based monitoring expert system, wherein at least one rule enables a prediction of equipment exhaustion, and Pisello, which is cited by the Examiner as teaching a program for creating one or more analytical reports about a monitor set, wherein at least one of the analytical reports details a relationship between demand and capacity for at least a portion of the equipment, fail to remedy the deficiencies of Kekic in this regard. Accordingly, it is apparent that, even when combined, the references do not teach the subject matter as claimed in independent claim 10; therefore, the subject rejection thereof should be withdrawn.

Thus, at least the foregoing reasons, the Examiner's burden of factually supporting a *prima facie* case of obviousness with respect to the pending claims has clearly not been met, and the rejection under U.S.C. §103 should be withdrawn.

## **2. The Combination of References is Improper**

In addition, Kekic and Husseiny patents cannot be applied to reject independent claim 1 under 35 U.S.C. § 103, the Kekic, Husseiny, and Bergholm patents cannot be applied to reject independent claim 4 under 35 U.S.C. §103, and the Kekic, Husseiny, and Pisello patents cannot be applied to reject independent claim 10 under 35 U.S.C. §103 for at least the following mutually exclusive reason.

In particular, § 2142 of the MPEP also provides:

*...the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made.....The examiner must put aside knowledge of the applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole'.*

Here, none of the cited references teaches, or even suggests, the desirability of the combination of the teachings therein as specified above and as recited in claims 1, 4, and 10. Thus, it is clear that neither patent provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. § 103 rejection.

In this context, the MPEP further provides at § 2143.01:

*The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.*

In the above context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination.

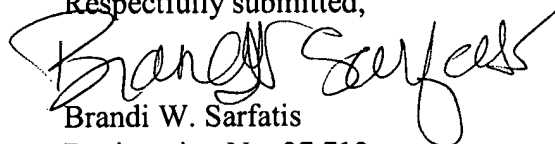
In the present case it is clear that the Examiner's combination arises solely from hindsight based on the invention without any showing, suggestion, incentive or motivation in either reference for the combination as applied to claims 1, 4, and 10. Therefore, for this mutually exclusive reason, the Examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

**Conclusion**

It is clear from the foregoing that claims 1, 4, and 10 are in condition for allowance. Claims 2-3, 5-9, and 11-20 depend from independent claims 1, 4, and 10 and are therefore also deemed to be in condition for allowance.

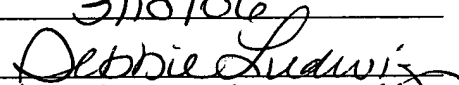
An early formal notice of allowance of claims 1-20 is requested.

Respectfully submitted,

  
Brandi W. Sarfatis  
Registration No. 37,713

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HAYNES AND BOONE, LLP  
901 Main Street, Suite 3100  
Dallas, Texas 75202-3789  
Telephone: 214/651-5896  
Facsimile: 214/200-0948  
Client Matter No.: 28787.70  
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